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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/360,262	07/26/1999	BRUCE K. REDDING JR.	DFG1004.5-US	3912

7590

08/23/2002

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EXAMINER

BECKER, DREW E

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 08/23/2002

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/360,262

Applicant(s)

REDDING ET AL.

Examiner

Drew E Becker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the appeal brief filed on June 24, 2002, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below due to the previous listing of claim 2 as being rejected under 35 U.S.C. 103(a) rather than 35 U.S.C. 102(e). Any inconvenience this may have caused is sincerely regretted.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

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3. Claims 1, 3-4, 6-7, 9, 15, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Redding Jr [Pat. No. 5,455,342].

Redding Jr teaches a method of treating polymers by dispersing the particulate polymer in a liquid (column 3, lines 3-11), applying an abrupt pressure change to the dispersion with a piston (column 3, lines 12-16), mechanical action (column 5, lines 50-66), recovering the treated polymers in a collection vessel (column 6, line 61), drying at 40°C (column 9, line 66), the pressure treatment occurring at ambient temperature which was commonly accepted to be 25°C (column 8, line 25), modifying the water and oil holding properties of the polymers including disintegration and solubility, thermal profile, turbidity profile, and viscosity (column 7, lines 1-12), and the polymers including dietary fibers such as bark, carboxymethylcellulose, lignin, methylcellulose, proteins and other natural polymers listed in the Polymer Handbook (column 14, Table VI). Regarding the "modifying the water and oil holding capacities" of claim 1, these are inherent features of the process of Redding Jr since the same the material is used and it undergoes the same process steps and since Redding Jr already mentioned modifying the water and oil holding properties of the polymers including disintegration and solubility, thermal profile, turbidity profile, and viscosity (column 7, lines 1-12). The method steps utilized in the reference are the same as those instantly claimed, and thus the same results would also have been expected. The claimed characteristic of "modifying the water and oil holding capacities" is considered an inherent property and result of the referenced method, and not unique to the instant invention, absent any clear and convincing evidence or arguments to the contrary on the record.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 8, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Redding Jr.

Redding Jr teaches the above mentioned concepts as well as operating the air piston at 60-90 psi (column 8, line 13) and modified properties such as a raised melting point, and altered viscosity and solubility (column 7, lines 1-12). It would have been obvious to one of ordinary skill in the art to vary the treatment time and amount of particulate of Redding Jr since Redding Jr does not mention the amount of particulate used, since these options would have been done during the course of normal experimentation and optimization, and since the treatment time and amount of particulate used would have been dependent upon a multitude of factors such as the type of material treated, the type of liquid media used, the size and makeup of the material, and the pressure level to name but a few. It would have been obvious to one of ordinary skill in the art to dry the modified fiber of Redding Jr at a temperature of 70°C since Redding Jr already teaches drying at 40°C (column 9, line 66), since this temperature would have been used during the course of normal experimentation, and since a higher temperature would have provided faster drying and thus improved the rate of output. Regarding the "increase in

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total dietary fiber content" of claim 13, this would have been an inherent property of the process of Redding Jr since the same method steps and materials were used and since Redding Jr teaches a greater treatment time which would have produced the same effect. Furthermore, the recitation of an "increase in total dietary fiber content" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

6. Claims 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Redding Jr in view of The Polymer Handbook.

Redding Jr teaches the above mentioned concepts. Redding Jr does not recite the use of cellulose. The Polymer Handbook listed cellulose as a natural polymer (page 399). It would have been obvious to one of ordinary skill in the art to incorporate the cellulose of The Polymer Handbook into the invention Redding Jr since Redding Jr specifically included all natural polymers listed by The Polymer Handbook (column 14, line 56), since The Polymer Handbook listed cellulose as a natural polymer (page 399), and since Redding Jr teaches the use of bark which is essentially cellulose. The method steps utilized in the reference are the same as those instantly claimed, and thus the

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same results would also have been expected. The claimed characteristic of reducing "the water holding capacity and oil retention properties" is considered an inherent property and result of the referenced method, and not unique to the instant invention, absent any clear and convincing evidence or arguments to the contrary on the record. Regardless, the recitation of "the water holding capacity and oil retention properties" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

7. Claims 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Redding Jr as applied above, in view of Fennema [FOOD CHEMISTRY]. Redding Jr teaches the above mentioned concepts as well as altering the solubility and disintegration properties (column 7, line 5). Redding Jr does not teach the use of oat hull. Fennema teaches that oat bran was a good source of dietary fiber (page 218). It would have been obvious to one of ordinary skill in the art to include the oat bran of Fennema into the invention of Redding Jr since Redding Jr teaches the use of other compositions and the modification of other properties (column 14, line 22), since Redding Jr was directed to the treatment of natural polymers, and since Fennema

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teaches that dietary fibers, such as oat bran, were natural polymers as well (page 218). Regarding the "modifying the water and oil holding capacities" of claim 11, Redding Jr already mentioned modifying the water and oil holding properties of the polymers including disintegration and solubility, thermal profile, turbidity profile, and viscosity (column 7, lines 1-12). Regardless, the recitation of "modifying the water and oil holding capacities" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Response to Arguments

8. Applicant's arguments filed in the appeal brief of June 24, 2002 have been fully considered but they are not persuasive.

Applicants argue that the natural polymers of Redding Jr are only a portion of dietary fiber. This is not deemed persuasive since the commonly accepted definition of dietary fiber is simply nondigestible polymers as taught by Fennema (page 218). Applicants also argue that "dietary fibers consist of the roughage component of grains and woods". However, Fennema specifically teaches that "Dietary fiber is not

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necessarily fibrous in nature. Dietary fiber is a nutritional term that has nothing to do with its physical or chemical nature" (page 218).

Applicants argue that Redding Jr. does not teach modifying properties. However, applicants' attention is drawn to column 7, lines 1-13 of Redding Jr which specifically teaches modifying properties such as thermal profile, solubility, viscosity, and turbidity profile.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E Becker whose telephone number is 703-305-0300. The examiner can normally be reached on Monday-Thursday 7am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1495.



Drew Becker
August 22, 2002



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